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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,358	12/07/2001	Jo Vander Aa	214597	9146

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EXAMINER

CHU, JOHN S Y

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

067

Office Action Summary

Application No.

10/021,358

Applicant(s)

VANDER AA, JO

Examiner

John S. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the amendment filed September 9, 2003.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over VERMEERSCH et al '128 in view of KINGMAN et al and TENG et al '222.

VERMEERSCH et al '128 disclose a photosensitive lithographic printing plate as well as the method of on-press development which currently claimed. The photosensitive ingredients as recited in VERMEERSCH et al include a negative-working photosensitive ingredient of an aryldiazosulfonate, column 3, line 1 – column 6, line 2 for the disclose aryldiazosulfonate component. The reference discloses mounting said printing plate on a printing cylinder after imagewise exposure and developing the printing plate with an aqueous dampening liquid or/and ink.

VERMEERSCH et al lacks the use of a single-fluid developer ink that has a continuous phase and a discontinuous polyol phase as claimed.

KINGMAN et al discloses and teaches the use of a single-fluid ink developer used for lithographic printing plates which is comprised of a continuous ink and a non-aqueous polar solvent. This single-fluid ink is the same as the claimed single-fluid ink developer as recited in

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claim 1 of the current application and provides improved benefits over the conventional dual-fluid ink that includes an ink component and a separate fountain solution lithographic ink, see the abstract and the column 2, lines 8-17 for the improvement over the conventional dual-fluid inks.

TENG et al '222 discloses an on-press development method wherein column 11, lines 25-37 disclose that the lithographic printing plate can be developed with a recently introduced single-fluid ink made by Flint as an alternative to the development by a conventional fountain ink developer.

It would have been *prima facie* obvious to one of ordinary skill in the art of on-press lithographic printing plate development to use a single-fluid ink developer as the developing solution in place of the fountain/aqueous solution in the art of VERMEERSCH et al with the reasonable expectation of same or similar results of excellent printing endurance, ink acceptance and ink resistance.

Examiner's Response to the Attorney's Arguments

Initially at the outset the examiner notes that applicants have misstated combination of references in the rejection over claims 1,2 and 4-10. Page 7, subparagraph (a) traverses a rejection over "the Vermeersch '128 patent (U.S. Patent 5,786,128) **(or the Vermeersch '750 patent,**(for emphasis) U.S. Patent 6,030,750), in view of Teng and Klingman should be withdrawn...". This stated rejection includes in the alternative the VERMEERSCH et al '750 reference as a reference used in the rejection against claims 1,2 and 4-10, which turns out not to be a rejection actually given in the Office action of Paper No. 5.

The arguments by applicant have been carefully considered, however the rejections are repeated and made FINAL.

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Applicants are arguing that the combination of VERMEERSCH et al '128, KINGMAN et al and TENG et al '222 is improper based on the separate technologies of the primary reference to VERMEERSCH et al '128 and the secondary reference to TENG '222 and that there is no motivation to develop the printing plates by using a single-fluid developer.

The examiner believes that the current argument by applicants is flawed wherein applicants have overanalyzed the differences in the print plate technologies of VERMEERSCH et al and TENG'222 in order to discredit the *prima facie* case of obviousness. The examiner maintains and believes the aforementioned references are fully combinable based on the disclosures of the references for the following reasons:

First, it is recognized that the printing plate of VERMEERSCH et al '128 and TENG '222 possess different components to achieve an on-press lithographic printing plate, however both references disclose the same technological product which is the on-press lithographic printing plate being formed by the development with a fountain solution and an ink solution or an emulsion of a ink and fountain solution. Clearly the *prima facie* case of obviousness is relying on the same technological field of invention where a lithographic printing plate is developed to give a printing plate having hydrophobic areas and hydrophilic image areas to give a conventional wet press printing plate. Thus, the over analytical evaluation of the printing plates of the prior art to assert that the printing plates are in different are from a distinct technology is improper and flawed. The plates here though using different ingredients are achieving the same final results, which is to give a product which is capable of printing images relying on the hydrophobic and hydrophilic properties of the image areas after exposure and development.

Second TENG '222 refers to the exact same developing solutions which are used in his process as disclosed in VERMEERSCH et al '128 and teaches the suitability of single fluid ink developers for processing these printing plates.

Third, applicants have provided any objective evidence providing secondary considerations to overcome the obviousness rejection showing unexpected results over the prior art. The single fluid claimed is known and taught by KLINGMAN, and the knowledge of the use of these single fluid developers is suggested for use by TENG '222.

3. Claims 1,2 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over VERMEERSCH et al '750 in view of KINGMAN et al and TENG et al '222.

VERMEERSCH et al '750 disclose a photosensitive lithographic printing plate as well as the method of on-press development which is currently claimed. The photosensitive ingredients as recited in VERMEERSCH et al include a negative-working photosensitive ingredient of an thermoplastic polymeric particles which coalesces under heat, see column 6, lines 13-56. The reference discloses mounting said printing plate on a printing cylinder after imagewise exposure for development of the printing plate with an aqueous dampening liquid or/and ink.

VERMEERSCH et al lacks the use of a single-fluid developer ink that has a continuous phase and a discontinuous polyol phase as claimed.

KINGMAN et al discloses and teaches the use of a single-fluid ink developer used for lithographic printing plates which is comprised of a continuous ink and a non-aqueous polar solvent. This single-fluid ink is the same as the claimed single-fluid ink developer as recited in claim 1 of the current application and provides improved benefits over the conventional dual-

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fluid ink that includes an ink component and a separate fountain solution lithographic ink, see the abstract and the column 2, lines 8-17 for the improvement over the conventional dual-fluid inks.

TENG et al '222 discloses an on-press development method wherein column 11, lines 25-37 disclose that the lithographic printing plate can be developed with a recently introduced single-fluid ink made by Flint as an alternative to the development by a conventional fountain ink developer.

It would have been *prima facie* obvious to one of ordinary skill in the art of on-press lithographic printing plate development to use a single-fluid ink developer as the developing solution in place of the fountain/aqueous solution in the art of VERMEERSCH et al with the reasonable expectation of same or similar results of excellent printing endurance, ink acceptance.

Examiner's Response to the Attorney's Arguments

Initially at the outset the examiner notes that applicants have misstated combination of references in the rejection over claims 1-3, 5-10 and 17-28. Page 8, subparagraph (b) traverses a rejection over "the Vermeersch '750 patent (U.S. Patent 6,030,750) **(or the Vermeersch '128 patent, U.S. Patent 5,786,128)** (for emphasis) in view of Teng and Klingman should be withdrawn...". This stated rejection includes in the alternative the VERMEERSCH et al '128 reference used in the rejection against claims 1-3,5-10 and 17-28. This rejection is not actually given in the Office action of Paper No. 5, paragraph 4.

The arguments by the examiner as stated above are repeated herein wherein the reasons for maintaining the rejection are substantially discussed above in paragraph 2 of the current Office action. In summary the applicant has over analyzed the differences of the printing plates

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of the prior art so as to discredit the *prima facie* case of obviousness. The examiner believes and asserts that the references are fully combinable wherein the references are in the same technological field of wet development lithographic printing plates.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

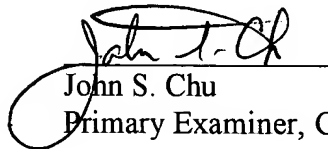
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

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The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



John S. Chu
Primary Examiner, Group 1700

J.Chu
November 24, 2003